between a center track and a drawer track and/or a relative motion between the center track and a support track. In other words, independent claim 18 describes a specific relationship between the damping device, the drawer track, the support track, and the center track in order to achieve the functional result recited in claim 18.

The arrangement of claim 18 allows a drawer to be fully extended from a body of a piece of furniture due to the presence of the center track between the drawer track and the support track. Unfortunately, however, the additional mass of the center track generates momentum when the drawer is moved in the opening or closing direction, and this momentum creates a considerable impact when the drawer reaches its stopping position. As a result, undesirable noise is developed which becomes even louder if the drawer is heavily loaded.

In view of the problems discussed above which particularly involve pull-out guide fittings including a drawer track, a support track, and a center track, the present invention has been developed in order to minimize the impact caused by the additional mass of the center track, thereby reducing the undesirable noise. In particular, the damping device arranged as discussed above absorbs the impact created due to the additional mass of the center track.

The Applicant acknowledges that pull-out guides with a drawer track, a support track, and a center track, such as the type taught in the Röck '726 reference, are well-known in the art. Furthermore, the Applicant acknowledges that damping mechanisms, such as the type taught in the Tamura reference, are also well-known in the art for reducing the shock of a drawer moving relative to the body of a piece of furniture. However, the Applicant respectfully submits that the relationship of the damping device with respect to the drawer track, the support track, and the center track as recited in claim 18 is <u>not</u> known or even suggested in the prior art. In other words, the Applicant respectfully submits that the *combination* of features arranged as recited in independent claim 18 is clearly patentable over the prior art of record.

As noted above, the Röck '726 reference teaches a well-known three-track pull-out guide fitting, including a drawer track, a support track, and a center track. The Tamura reference, on the other hand, discloses only a drawer track 7, a support track 3, and a damping device that can dampen a relative motion between the drawer track 7 and the support track 3. Although the Tamura reference

does not suggest a damping device arranged to dampen relative motion between a *center track* and either the drawer track 7 and the support track 3, the Examiner asserts that such an arrangement would be obvious in view of the combination of the Tamura reference and the Röck '726 reference. However, the Applicant respectfully disagrees with the Examiner's position, as explained below.

In item 8 on page 5 of the Office Action, the Examiner indicated that the arrangement of the damping device as recited in claim 18 would be obvious because it is well within the ability of one of ordinary skill in the art to position the damping device at different locations to dampen relative motion between various combinations of the tracks. The Examiner's apparent belief that only a minor, obvious modification of the teachings of the Tamura reference and the Röck '726 reference is necessary to produce the invention of claim 18 appears to be due to a lack of appreciation for the advantages gained and difficulties involved in arranging the damping device as recited in claim 18. In particular, the arrangement provides significant advantages with respect to the additional momentum and drawbacks caused by the presence of the center track. However, providing a drawer track, a center track, and a support track also creates significant difficulties when mounting a damping device so as to dampen a relative motion between the center track and at least one of the drawer track and the support track. In this regard, an Appendix has been prepared and attached hereto to help illustrate these difficulties. The Appendix includes Figure A, which is a cross-sectional view of the three tracks forming a typical embodiment of the invention of claim 18, and includes Figures B and C, which are schematic views of a particular embodiment of the invention of claim 18.

As illustrated in Figure A, providing three separate tracks allows only a very small amount of space therebetween in which to locate the damping device. Figure B illustrates one embodiment of the pull-out guide fitting as recited in claim 18, in which the damping device is located so as to dampen the relative motion between the center track and the drawer track. In this view, the pull-out guide fitting is shown in the fully-open position, and space constraints for the damping device are not necessarily a concern. However, when the pull-out guide fitting is in the closed position as shown in Figure C, the space constraints due to the three tracks become a significant concern. It is submitted that the space constraints created by providing a center track in addition to a drawer track

and a support track would deter one of ordinary skill in the art from attempting to modify the Tamura reference and the Röck '726 reference so as to dampen relative motion between the center track and at least one of the drawer track and the support track.. Thus, it is submitted that the present invention as recited in claim 18 is not a simple re-arrangement of parts as suggested by the Examiner.

Moreover, the Examiner has still not provided any reason why one of ordinary skill in the art would be motivated to address the difficulties discussed above and modify the Tamura reference and the Röck '726 reference as suggested by the Examiner. In the remarks filed August 11, 2004, the Applicant noted that it has been well-established that there must be some clear motivation, suggestion, or teaching of the desirability of making *the specific combination* produced by the Applicant. See *In re Dance,* 160 F.3d 1339, 48 USPQ2d 1635 (Fed. Cir. 1998). In addition, the specific reasons why one of ordinary skill in the art would be motivated to select the references and to combine them in a manner so as to render the claimed invention obvious must be clearly set forth by the Examiner. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with *no knowledge of the claimed invention*, would have selected these components for combination in the manner claimed" (emphasis added)). This is particularly relevant in the present case, in which the difficulties of arranging the damping device as recited in claim 18 would deter one of ordinary skill in the art from attempting such an arrangement without a clear motivation.

As evidence of such motivation, the Examiner explains in item 10 on page 6 of the Office Action that "Röck '726 teaches the idea of providing a center track in order to allow the drawer to be pulled out of the body of a piece of furniture over its entire length and to facilitate the reinsertion of the drawer into the body of the furniture." As noted above, however, the Applicant acknowledges that such an arrangement is well-known in the art. This statement does not, however, provide any specific reasons why one of ordinary skill in the art would be motivated to *modify* the Röck '726 reference by arranging the damping device as recited in claim 18.

In view of the lack of any clear teaching as to why one of ordinary skill in the art would arrange a damping device with respect to a center track as recited in claim 18, the Applicant previously noted that the Examiner is using impermissible hindsight in order to arrive at the

determination that the invention is obvious in view of the applied references. In response to this statement, the Examiner noted in item 9 on page 5 of the Office Action that a determination of obviousness is necessarily based upon hindsight reasoning as long as that reasoning "does not include knowledge gleaned only from the applicant's disclosure." However, because the Examiner has not explained where such knowledge has been obtained as explained above, the Applicant assumes that such knowledge must have impermissibly been gleaned *only* from the Applicant's own disclosure. As such, it is submitted that the Examiner's obviousness rejection is improper and should be withdrawn.

As explained above, the combination of the Tamura reference and the Röck'726 reference does not disclose or suggest the arrangement of a damping device as recited in claim 18. In addition, the Migliori reference also does not suggest such an arrangement. Therefore, one of ordinary skill in the art would not be motivated to modify or combine the Tamura reference, the Röck '726 reference, and the Migliori reference in order to obtain the invention recited in independent claim 18. Accordingly, it is respectfully submitted that independent claim 18 and the claims that depend therefrom are clearly patentable over the prior art of record.

In view of the above amendments and remarks, it is submitted that the present application is now in condition for allowance. However, if the Examiner should have any comments or suggestions to help speed the prosecution of this application, the Examiner is requested to contact the Applicant's undersigned representative.

Respectfully submitted,

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